

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

DeGrado *et al.*

Application No.: 10/801,951

(Appeal No. 2010-005832)

Filed: March 17, 2004

For: **Facially Amphiphilic Polymers and
Oligomers and Uses Thereof**

Confirmation No.: 2895

Art Unit: 1627

Examiner: CHONG, Yong Soo

Att. Docket: 1694.0630003/JMC/M-R

**Petition Under 37 C.F.R. § 1.182 & § 41.3 to Admit New Evidence and
Supplemental Material**

Chief Administrative Patent Judge
Appeal Related Matters
Board of Patent Appeals and Interferences
US Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

Pursuant to 37 C.F.R. § 1.182 and § 41.3, Applicants petition the Chief Administrative Judge to admit new evidence and other supplemental material in support of Applicants' Response to the Order for Further Briefing ("Response"), which is filed concurrently herewith. The captioned application is now on appeal to the Board of Patent Appeals and Interferences ("Board"). Applicants have concurrently filed a petition under 37 C.F.R. § 1.183 ("Rule 183 petition") to suspend 37 C.F.R. § 41.33(d)(2), which prohibits entry of affidavits or other evidence during appeal of *ex parte* cases to the Board. Our reasoning is set forth below.

New Evidence

On May 9, 2011, the Board issued an Order for Further Briefing ("Order") requiring Applicants to brief new issues that were not raised during initial examination or in the present appeal to the Board. Those issues included:

1. "Whether Applicants may be required to restrict their claims to a single invention under the provisions of 35 U.S.C. §121;" and
2. "Whether Claim 16 is a proper 'Markush Claim.'" (Order at 2.)

On the second question, the Board further stated:

"Applicants are also required brief whether, considering only the oligomers defined by Formula II in Claim 16, the 21 groups identified by the Examiner are unrelated inventions. Stated another way, do those groups share any additional structural or functional features that would establish unity of invention?"

(Order at 12.)

The cases cited by the Board in its Order have established that determining whether a claim has an improper Markush group is decided on the facts on a case-by-case basis. *In re Harnisch*, 631 F.3d 716, 722 (C.C.P.A. 1980); *Ex Parte Hozumi* 3 USPQ, 1059, 1060 (Bd. Pat. App. & Int. 1984).

The only issues in this appeal *prior to* the Board's Order concerned obviousness-type double-patenting rejections. And the Examiner never raised any rejection for improper Markush claims during original prosecution. The Applicants therefore have had no reason or opportunity to present the evidence needed to address the Board's fact-intensive questions concerning the Markush claims in this case. Applicants therefore request that the following new evidence be entered:¹

- Declaration of Richard W. Scott, Ph.D. Under 37 C.F.R. § 1.132 (Exhibit F)

The Applicants have relied upon this declaration in direct support of the factual positions taken in the concurrently filed Response.

¹ Applicants have questioned the Board's authority to raise the Markush issues and this petition to admit new evidence and supplemental materials should not be construed as an admission of the propriety of the Board's actions in this case.

Supplemental Material

Applicants also request that the following supplemental material be admitted. The supplemental material is a matter of public record and is provided for the convenience of the Board. Applicants therefore request that Exhibits A-E and G-L² be admitted into the record in this case.

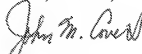
- U.S. Patent No. 7,678,801 (Exhibit A)
- U.S. Patent No. 7,825,216 (Exhibit B)
- U.S. Patent No. 7,897,596 (Exhibit C)
- U.S. Patent No. 7,932,242 (Exhibit D)
- U.S. Patent No. 7,939,553 (Exhibit E)
- Considine, D.M., ed, *Van Nostrand's Scientific Encyclopedia*, 8th ed., p. 226, Van Nostrand Reinhold, New York, NY (1995) (Exhibit G)
- Jenkins, M., American Bar Association Comments on Proposed Changes to Restriction Practice in Patent Applications, (August 11, 2010) (Exhibit H)
- Kirk, M.K., American Intellectual Property Law Association Response to Notice Requesting Comments on Proposed Changes to Restriction Practice in Patent Applications, (August 13, 2010) (Exhibit I)
- PCT Examination Guidelines, Chapter 10 – Unity of Invention (Exhibit J)
- Testimony of H.C. Wegner in response to Proposed Rulemaking, “Examination of patent applications that include claims containing alternative language”, pp. 1-18 (August 10, 2007) (Exhibit K)
- Comments of the Biotechnology Industry Organization on the United States Patent & Trademark Office Proposed Rule Changes Concerning Claims Containing Alternative Language (October 9, 2007) (Exhibit L).

² Exhibit references for the above-listed items correspond to the exhibits to Applicants’ Response to Order for Further Briefing. Copies of the new evidence are not included with this petition, but can be found appended to Applicants’ Response to Order for Further Briefing.

The above-listed supplemental material is referred to and relied on in support of various positions taken in the Applicants' concurrently filed Response. Applicants therefore respectfully ask that the above listed new evidence be entered in the file of the captioned application. This petition is being filed electronically in the matter of *Ex Parte Degrado et al.*, Appeal No. 2010-005832, Application No. 10/801,951, Technology Center 1600. The petition fee under 37 C.F.R. §1.17(f) in the amount of \$400.00 is submitted with this petition. Any part of the petition fee not paid herewith is hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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